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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,041	03/04/1999	DAVID GEORGE HALLEY	FA/153A	7973

7590 02/26/2002  
GARY A SAMUELS  
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NEWARK, DE 197149206

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

13

DATE MAILED: 02/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/155,041

Applicant(s)

HALLEY ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on November 27, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/155,041 is acceptable and a CPA has been established. An action on the CPA follows.

2. Since no response was filed the action that follows is a substantial repeat of the previous Office Action.

### ***Response to Amendment***

1. Amendment A, submitted as Paper No. 7 on January 18, 2001, has been entered. Claims 30 – 57 have been cancelled. Claims 23 and 24 have been amended. Therefore, the pending claims are 1 – 29.

2. The amendment to the claims are sufficient to withdraw the objection to claim 24 set forth in section 1 of the last Office Action. Additionally, the 35 USC 112 2<sup>nd</sup> rejection to claim 23 set forth in section 3 of the past Office Action are withdrawn due to the amendment.

3. Applicant's arguments (page 2 of Amendment A) regarding the 35 USC 112 1<sup>st</sup> rejection set forth in section 2 of the previous Office Action have been found persuasive. Thus, the rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 – 20, and 22 – 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blauer et al. (5,626,949) in view of Henn et al. (5,026,591) for the reasons of record.

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6. Claim 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Blauer et al. in view of Henn et al. as applied to claim 20, and in further view of Gore et al. (4,194,041) for the reasons of record.

***Response to Arguments***

7. Applicant's arguments filed January 18, 2001, have been fully considered but they are not persuasive. Applicant argues that the combination of Blauer et al. and Henn et al. is improper since Examiner used hindsight as the reason to combine. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues that combination was improper since it would not be obvious to use a method taught to impart "dimensional stability" to impart the claimed abrasion resistance. Although Blauer et al. does state that the external durability is due to the woven fabric layer and not the polyurethane stratum, the polyurethane stratum layer would inherently increase abrasion resistance to the water-resistant, breathable fabric. Adding an additional layer, in this case the polyurethane layer, to a fabric will inherently increase the abrasion resistance to the fabric since there is an extra layer between the fabric and the abrading object. Thus, any layer that further separates the fabric layer from the abrading object will increase the abrasion resistance to the

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fabric since the intermediate layer will need to be abraded off before the fabric will begin to abrade.

Further, the references need not be combined for the same reason as Applicant. Thus, adding the polyurethane layer to the water-resistant, breathable fabric for dimensional stability reasons would produce the same product structurally, a two-layered water-resistant, breathable composite with a polyurethane coating. Therefore, Examiner's combining Blauer et al. with Henn et al. is valid.

Applicant further argues that the dot shape would not have been a matter of design choice. It is noted that the Applicant discloses the dot pattern is used to solve the problem of poor abrasion resistance. However, as mentioned above, any layer would inherently increase the abrasion resistance. Thus, it is not critical to the invention that the polyurethane layer be applied as a dot pattern. Other patterns, such as the ones disclosed by Blauer et al. and variations of the dot pattern such as ovals or rings would also increase the abrasion resistance. Thus, the shape the polyurethane droplets are applied is a matter of design choice. It would have been obvious to one having ordinary skill in the art to apply the polyurethane coating in a dot pattern since the added thickness puts more distance between the abrading object and the fabric layer while having the least amount of contact between the polyurethane layer and the wearer. By minimizing the amount of material that comes into contact with the skin, the fabric will have better air circulation within the fabric or garment helping perspiration to evaporate better causing the wearer to feel dryer and more comfortable.

Additionally, Applicant argues that it is not obvious that the harder, stronger polyurethane taught by Blauer et al. would have the claimed elastic modulus. However, it is

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reasonably to presume the elastic modulus would be within Applicant's claimed range. Blauer et al. states that a harder and stronger urethane should be chosen to prevent the polyurethane layer from washing off (column 4, lines 27 – 31), thus the polyurethane used is more durable and less likely to rub or abrade. Blauer et al. also discloses that the polyurethane should be a high-tensile-strength and highly flexible elastomer (column 3, lines 43 – 44). Further, since both products are used as inner layers on outerwear fabrics, they would require similar strength and durability to be effective and not wear off, thus the polyurethane in Blauer et al. would be within the Applicant's claimed elastic modulus range.

Finally, Applicant traverses the rejection of the claims to a garment as an intended use. Applicant states the term "garment" connotes structure of clothing which is understood by one having ordinary skill in the art. Examiner withdraws the rejection of claims 28 and 29 based on the position that the claims recite intended use. However, based on Applicant's definition of garment as clothing claims 28 and 29 are rejected by Blauer et al. in view of Henn et al. since it would be obvious to one having ordinary skill in the art to make the fabric into clothing. Also, Blauer et al. teaches the fabric can be constructed into coats, pants, jackets, boots, gloves and other outer clothing (column 1, lines 12 – 14). Further it is well known to use fabric to make clothing.

For the reasons stated above Applicant's arguments have not been found persuasive.

Thus, the rejections are maintained.

### ***Conclusion***

3. This is a continuation of applicant's earlier Application No. 09/155,041. All claims are drawn to the same invention claimed in the earlier application and could have been finally

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rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (8:00am - 4:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 872-9311 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Jenna-Leigh Befumo  
February 25, 2002



CHERYL A. JUSKA  
PRIMARY EXAMINER